

REMARKS

Reconsideration of this application, in view of the foregoing amendment and the following remarks, is respectfully requested.

Claims 1-114 were originally presented for consideration in this application. Claims 16-31 and 89-114 are withdrawn from consideration as being non-elected in response to a requirement for restriction. Claims 16-31, 60-64, 69, 72, 73 and 88-114 have been canceled. Accordingly, claims 1-15, 32-59, 65-68, 70, 71 and 74-87 are currently pending in this application.

The examiner's indication that claims 1-15, 37-59, 65-68 and 84-86 are allowed is noted with appreciation.

The following rejections and objections were set forth in the Office Action:

1. The drawings are objected to for failure to show every feature of the invention specified in the claims;
2. Claims 74-82 are rejected under 35 USC §112 as lacking enablement in the specification;
3. Claims 60, 62-64, 74 and 79 are rejected under 35 USC §102 as being anticipated by U.S. Patent No. 5,839,508 to Tubel, et al.;
4. Claims 69, 72 and 73 are rejected under 35 USC §102 as being anticipated by U.S. Patent No. 3,970,877 to Russell, et al.;
5. Claim 83 is rejected under 35 USC §103 as being obvious over Russell in view of U.S. Patent No. 4,387,318 to Kolm, et al.;
6. Claims 70, 71, 73 and 87 are rejected under 35 USC §103 as being obvious over Russell; and

7. Claim 79 is objected to under 37 CFR §1.75 as being a substantial duplicate of claim 74.

Regarding the objection to the drawings, and the rejections of claims 74-82, please note that every feature recited in the claims is illustrated in the drawings. For example, with regard to independent claim 74, the drawings clearly illustrate and the written description clearly describes embodiments of the recited vibrating assembly (elements 156, 158, 160, 162, 210, 228, 254, 272 and 286 in the drawings), generator (elements 30, 76, 92, 126, 166, 188, 196, 202, 250 and 274 in the drawings), electromagnetically active material (elements 94, 168 and 266 in the drawings), magnet (elements 82 and 204 in the drawings) and coil (elements 84 and 206 in the drawings). The recited limitations (e.g., the vibrating assembly displacing in response to fluid flow across the vibrating assembly) are also clearly described in the specification.

The objection and rejections seem to center on the fact that certain claimed combinations of the features are not specifically shown in the drawings. The rules do not require that every claimed combination of features be shown in the drawings, only that the features themselves be shown in the drawings.

Furthermore, the specification specifically states that any of the described electrical power generating systems can include any of the generators, and any combination of the generators, described therein (see the last paragraph of the written description). Therefore, the combinations of features recited in claims 74-82 are clearly enabled by the specification. Accordingly, the examiner is respectfully requested to withdraw the objection to the drawings and the rejections of claims 74-82.

Regarding the anticipation rejections of claims 60, 62-64, 74 and 79, please note that claims 60-64 have been canceled above. As for claims 74 and 79, the Tubel reference clearly does not describe the generators recited in these claims. For example, claim 74 recites that the generator includes an electromagnetically active material, and a magnet and coil, strain being produced in the electromagnetically active material and

electricity being produced in the coil in response to displacement of the vibrating assembly. Claim 79 recites that the generator includes an electromagnetically active material, and a magnet and ferromagnetic core, strain being produced in the electromagnetically active material and electricity being produced in the coil in response to displacement of the vibrating assembly.

Since Tubel does not describe the generators recited in claims 74 and 79, Tubel cannot anticipate these claims. Therefore, the examiner is respectfully requested to withdraw the rejections of claims 74 and 79.

Regarding the anticipation rejections of claims 69, 72 and 73 over the Russell reference, please note that these claims have been canceled above.

Regarding the obviousness rejection of claim 83 over the Russell and Kolm references, this rejection is respectfully traversed. A *prima facie* case of obviousness has not been made out, for at least the reasons that sufficient motivation for making the proposed combination of the references has not been set forth, and the proposed combination would not work.

In the Office Action it is proposed that a person skilled in the art would find it obvious to use the lift reversal device taught by Kolm in the vibrating assembly taught by Russell. However, the Russell vibrating assembly works on the principle of creating turbulence in flow in a wellbore annulus, and using this turbulence to vibrate a flexible disc exposed to the annulus flow (see col. 2, lines 20-25). A person skilled in the art would definitely not place the vane 16 described by Kolm in a wellbore annulus where it would be subject to certain damage.

In addition, there is no mechanism taught by Russell or Kolm for converting the fluttering motion of Kolm's vane 16 into vibratory motion of Russell's disc 10. Furthermore, the proposed combination is also a less desirable combination than the one taught by Russell, since the turbulence-inducing rib 11 is a much more desirable,

robust, damage resistant and simple construction for use in a wellbore annulus than the delicate fluttering vane 16 taught by Kolm.

For at least the above reasons, a *prima facie* case of obviousness of claim 83 has not been made out. Therefore, the examiner is respectfully requested to withdraw the rejection of claim 83.

Regarding the obviousness rejections of claims 70, 71, 73 and 87 over the Russell reference, these rejections are respectfully traversed. Russell clearly does not describe the features of the invention recited in these claims, and so a *prima facie* case of obviousness has not been made out. Please see MPEP § 2143.03 (“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”).

Independent claim 70 recites that electricity is produced in a coil of a generator in response to strain being produced in an electromagnetically active material, which is not taught or suggested by Russell. Independent claim 71 recites that strain is produced in a magnetostrictive material in response to displacement of a vibrating assembly, which is not taught or suggested by Russell. Independent claim 87 recites that displacement of the vibrating assembly in response to the fluid flow is initiated by producing strain in the electromagnetically active material, which is not taught or suggested by Russell.

Therefore, a *prima facie* case of obviousness of claims 70, 71 and 87 has not been made out, and the examiner is respectfully requested to withdraw these rejections.

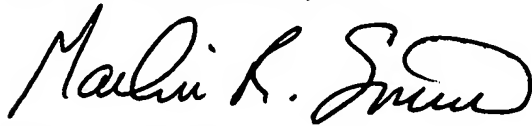
Regarding the double patenting objection to claim 79, the objection is respectfully traversed. Claim 79 recites displacement of a magnet relative to a ferromagnetic core, whereas claim 74 recites displacement of a magnet relative to a coil. A ferromagnetic core is not the same thing as a coil. These are not substantial duplicates. Therefore, the examiner is respectfully requested to withdraw this objection.

In view of the foregoing amendment and remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 1-15, 32-59, 65-68, 70, 71 and 74-87 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned attorney of record at (972) 516-0030 if such would expedite the prosecution of the application.

Respectfully submitted,

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